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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,836	02/23/2004	Masahiro Ozawa	100725-00119	5424
4372	7590	02/23/2005	EXAMINER	
ARENT FOX KINTNER PLOTKIN & KAHN 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			COMPTON, ERIC B	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/782,836

Applicant(s)

OZAWA ET AL.

Examiner

Eric B. Compton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5 and 9 is/are rejected.
- 7) ☒ Claim(s) 2-4,6-8 and 10-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/024,489.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/23/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Priority*

1. The statement of priority should be amended to reflect the issuance of the parent application.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 5, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. 6,597,515 to Sahashi et al ("Sahashi").

The applied reference has common inventors: Ozawa, Sahashi, Hozumi, and Sone, with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, the reference discloses:

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FIG. 1 shows an embodiment structured such that the stem portion 45 of the outer joint member 40 having an uneven portion 48 formed on an outer peripheral surface of the axial end portion is fitted to the through hole 16 of the hub 10. Then, by expanding a portion of the stem portion 45 in which the uneven portion 48 is formed, from an inner diameter side to an outer diameter side as shown by a reference numeral 47, the uneven portion 48 eats into the inner peripheral surface of the through hole 16 of the hub 10, thereby plastically connecting the hub 10 to the outer joint member 40.

In the case that the expansion mentioned above is performed by a press formation, for example, after pressure fitting the stem portion 45 of the outer joint member 40 to the through hole 16 of the hub 10 as shown in FIG. 2, the stem portion 45 is expanded from the inner diameter side to the outer diameter side by pressure fitting the stem portion 45 of the outer joint member 40 into the through hole 46 by moving a caulking jig 54 having a diameter greater than an inner diameter of the through hole 46 in a direction of an arrow in a state of supporting a bottom of the mouth portion 43 of the outer joint member 40 by means of a backup jig 52. A portion of the stem portion 45 caulked by the expansion, that is, a caulked portion is denoted by reference numeral 47. Accordingly, the uneven portion 48 of the stem portion 45 eats into the inner peripheral surface of the through hole 16 of the hub 10, whereby the hub 10 and the outer joint member 40 are plastically connected.

Col. 11, lines 27-54.

Regarding claim 5, see embodiment shown in Figures 21-22.

Regarding claim 9, see embodiment shown in Figures 1-2.

### ***Allowable Subject Matter***

4. Claim 2-4, and 6-8, and 10-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Sahashi discloses the subject matter above used in the rejections above, but does not disclose the subject matter of claims 2-4, 6-8, 10-12.

Effective November 29, 1999, 35 U.S.C. 103(c) provides that subject matter developed by another which qualifies as "prior art" only under one

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or more of subsections 35 U.S.C. 102(e), (f) and (g) is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made. 35 U.S.C. 103(c) applies only to subject matter which qualifies as prior art under 35 U.S.C. 103; it does not affect subject matter which qualifies as prior art under 35 U.S.C. 102, i.e., anticipatory prior art. See MPEP § 706.02(l) - § 706.02(l)(3).

MPEP § 2146. Both U.S. Pat. 6,497,515 and the parent application 10/024,489, now U.S. Pat. 6,773,165 share the same assignee: NTN Corporation. "In the case of a division or continuation application, a prior assignment recorded against the original application is applied to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications." MPEP § 306.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (571) 272-4527. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric B. Compton  
Primary Examiner  
Art Unit 3726

ebc